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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/526,688	03/03/2005	Kazuo Kohmura	MITSP101US	5294
23623	7590	10/28/2009		
TUROCY & WATSON, LLP 127 Public Square 57th Floor, Key Tower CLEVELAND, OH 44114				
EXAMINER				
MOORE, MARGARET G				
ART UNIT		PAPER NUMBER		
1796				
NOTIFICATION DATE		DELIVERY MODE		
10/28/2009		ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

doctet1@thepatentattorneys.com

hholmes@thepatentattorneys.com

lpasterchek@thepatentattorneys.com

Office Action Summary

Application No.

10/526,688

Applicant(s)

KOHMURA ET AL.

Examiner

Margaret G. Moore

Art Unit

1796

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 August 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 3, 4, 6-8, 15, 16, 18 and 20 to 23 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 3, 4, 6-8, 15, 16, 18, 20 and 21 is/are rejected.
- 7) ☒ Claim(s) 22, 23 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 8/13/09 has been entered.

2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

3. Claims 1, 3, 6-8, 15, 18, 20 and 21 rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Weidman.

The teachings of Weidman et al. and how they apply against the instant claims were addressed in previous office actions and as such this will not be repeated. Applicants' remarks filed 8/13/09 have been considered but are not deemed persuasive in establishing an inherent difference between the instant claims and that in the prior art.

Applicants' traversal stresses the fact that the deposited TMCTS in Weidman et al. forms a layer while the instant claims are drawn to a method of modifying a porous film. There is nothing to indicate that such a layer is excluded from the claimed process. To this extent, the Examiner refers applicants to page 27 of the instant specification which specifically states that "a film is formed on at least a part of the surface... of the porous film". Thus, not only is there nothing excluding the formation of a film from the instant claims, it appears to be a contemplated or possible embodiment when one considers the teachings in the specification.

Applicants also argue that TMCTS will not treat the inside surface of the pores in the prior art due to the fact that 1) it forms a layer over the silica film and 2) it is so susceptible to polymerization that it will polymerize before reaching the surface of the silica film.

With regard to the first argument, the Examiner addressed this position in the previous office action, that one would expect at least some of the TMCTS to inherently enter the pores in Weidman et al. due to the relative sizes thereof.

With regard to the second argument, applicants refer to various patents that they believe support this position. The Examiner does not agree.

While most of these patents refer to the potential of TMCTS to react in delivery lines, 7,531,590 actually summarizes the main problem with applicants' argument. This reference notes on column 1, lines 47 and on, that TMCTS reacts with oxygen or other components in air to degrade. Weidner et al. specifically uses a non-oxidizing plasma. There is nothing that suggests that such premature polymerization will occur in the specific process environment used in Weidner et al.

In view of this, the Examiner does not find applicants' arguments persuasive of an inherent difference between the claimed process and that in the prior art.

With regard to the Declaration under Rule 123, this data fails to establish that the claimed process and that of the prior art are inherently different. In addition, the Examiner notes that the reaction conditions in the exemplary embodiments are not commensurate in scope with the breadth of the claims such that the claims encompass more processes than those actually shown. For instance, the claims allow for plasma deposition.

4. Claims 4 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Weidner et al.

The teachings of Weidner et al. and how they apply to the instant claims were noted in previous office actions. As such this will not be repeated. Applicants rely on the limitations in claim 1 to overcome this rejection. Since this is not persuasive (see above), this rejection is also maintained.

5. Claims 22 and 23 are objected to as being based on a rejected base claim, but containing allowable subject matter. The teachings in Weidman et al. fail to teach or suggest a process as claimed in which water is added. As an aside, and in an effort to

expedite prosecution, the Examiner notes that claims consistent with those pending but requiring that the "gas phase" contain air would be considered allowable over the prior art as well. Support for this language can be found on page 25 of the instant specification. Weidner et al. require a non-oxidizing atmosphere. See column 8, line 34.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Margaret G. Moore whose telephone number is 571-272-1090. The examiner can normally be reached on Monday and Wednesday to Friday, 10am to 4pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Seidleck can be reached on 571-272-1078. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Margaret G. Moore/
Primary Examiner, Art Unit 1796

mgm
10/26/08